



UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office

Patent Cooperation Treaty
Legal Office

Address: Assistant Commissioner for Patents
Box PCT
Washington, D.C. 20231

31 JUL 1998

HOFFMAN WASSON & GITLER
2361 JEFFERSON DAVIS HIGHWAY, SUITE 522
ARLINGTON, VA 22202

In re Application of : DECISION ON
Louis Ryles :
Application No.: 08/850,922 : PETITION
Filing Date: 02 May 1997 :
Attorney's Docket No.: A-5816 : UNDER 37 CFR 1.182
For: LIQUID FILTERING APPARATUS :
: :
:

This is in response to applicant's petition under 37 CFR 1.182 to convert the application to a filing under 35 U.S.C. §371 filed 03 October 1997. The \$130.00 petition fee has been paid by check.

BACKGROUND

On 06 November 1995, applicant filed international application PCT/AU95/00735, which claimed priority of an earlier Australian application filed 04 November 1994. A Demand for international preliminary examination, in which the United States was elected, was filed prior to the expiration of the nineteenth month from the priority date. Accordingly, the thirty-month period for paying the basic national fee in the United States expired at midnight on 05 May 1997 (04 May 1997 fell on a Sunday).

On 02 May 1997, applicant filed a transmittal letter for the filing of a utility application under 35 U.S.C. 111 and 37 CFR 1.53, which was accompanied by, *inter alia*, a specification, claims and five sheets of drawings. The application was processed as a filing under 35 U.S.C. 111(a) and accorded a 02 May 1997 filing date.

On 27 September 1997, the Office of Initial Patent Examination (OIPE) mailed a Notice To File Missing Parts of Application (Form PTO-1533) indicating that the basic filing fee, extra claim fees and an oath or declaration were required together with a surcharge payment. A Two Month time period for response was set in the Notice.

On 03 October 1997, applicant filed the present petition together with a response to the Notice. Petitioner requests that the application be converted to a national stage application filed under 35 U.S.C. 371.

DISCUSSION

Any intended filing of an international application as a national stage application must clearly and unambiguously be identified as such and must satisfy all of the conditions set forth in 35 U.S.C. 371(c). The official PTO Notice published in the Official Gazette at 1077 OG 13 entitled "Minimum Requirements for Acceptance of Applications Under 35 U.S.C. 371 (the National Stage of PCT)" states, in part, the following:

The Patent and Trademark Office is continuing to receive application papers which do not clearly identify whether the papers (1) are being submitted to enter the national stage of the Patent Cooperation Treaty (PCT) under 35 U.S.C. 371 or (2) are being filed as a regular national application under 35 U.S.C. 111.

* * *

To clearly indicate an international application is being filed under 35 U.S.C. 371 the applicant should use the "Transmittal Letter for United States Designated Office" (Form PTO-1390) as the transmittal letter.

Alternatively, one of the following indications may be used:

- 1) the applicant shall clearly state in the transmittal or cover letter that he or she is filing under 35 U.S.C. 371 or entering the national stage under PCT; or
- 2) the applicant clearly identifies in the oath or declaration the specification to which it is directed by referring to a particular international application by PCT Serial Number and International Filing Date and that he or she is executing the declaration as, and seeking a U.S. Patent as, the inventor of the invention described in the identified international application.

* * *

If there are any conflicting instructions as to which sections of the statute (371 or 111) is intended the application will be accepted under 35 U.S.C. 111.

Applicant's transmittal letter filed 02 May 1997 did not request treatment under 35 U.S.C. 371, therefore the application was properly treated as an application under 35 U.S.C. 111 (37 CFR 1.495(g)). Thus, applicant did not indicate that the papers initially submitted on 02 May 1997 were to be treated as a national stage application under 35 U.S.C. 371.

Moreover, the basic national fee was not timely submitted prior to the expiration of the thirty month deadline for entry into the national stage. Moreover, applicant did not

indicate that he wished to pay the \$1040.00 basic national filing fee at the time of filing the 02 May 1997 submission. Therefore, applicant did not pay the full national basic fee. The international application became abandoned as to the United States for failure to pay the basic national fee by midnight on 05 May 1997 (35 U.S.C. 371(d) and 37 CFR 1.495(h)). Accordingly, applicant's request to convert to 35 U.S.C. 371 filing status cannot be granted because if the application was filed under 35 U.S.C. 371 the application would be abandoned for failure to pay the basic national fee by 05 May 1997, the expiration of thirty months from the priority date.

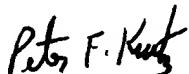
Applicant is entitled to claim benefit under 35 U.S.C. 120 and 365(c) of the filing date of the international application for the common subject matter, if this application (Serial No. 08/850,922) and the international application (PCT/AU95/00735) designating the United States were copending on 02 May 1997. In order to obtain benefit of the earlier international application, applicant must amend the beginning of the specification of this application by inserting a proper reference to the parent international application. An appropriate passage would be, "This is a continuation of international application PCT/AU95/00735, filed 06 November 1995 which designated the United States and is now abandoned."

Applicant is reminded that in order to perfect the claim for priority under 35 U.S.C. 119, applicant must submit a certified copy of the priority document. The certified copy of priority document submitted to the International Bureau for the national stage cannot be relied upon to perfect the claim for priority. See MPEP § 1896.

CONCLUSION

The petition to convert the application from a 35 U.S.C. 111 filing to a national stage application under 35 U.S.C. 371 is DISMISSED without prejudice.

This application is being returned to the Initial Patent Examination Division of the Office of Initial Patent Examination for consideration of the response filed 03 October 1997.



Peter F. Kratz
Legal Examiner
PCT Legal Office

PFK:pfk

Telephone: (703) 308-4313
Facsimile: (703) 308-6459